

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 56

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN E. BROWN

Appeal No. 95-1971
Application No. 08/126,130¹

HEARD: March 10, 1999

Before MEISTER, FRANKFORT and GONZALES, ***Administrative Patent Judges***.

MEISTER, ***Administrative Patent Judge***.

DECISION ON APPEAL

¹ Application for patent filed September 24, 1993. According to appellant, this application is a continuation of Application No. 07/853,846 filed March 19, 1992, now abandoned; which is a continuation of Application No. 07/614,486 filed November 16, 1990, now abandoned.

Appeal No. 95-1971
Application No. 08/126,130

John E. Brown (the appellant) appeals from the final rejection of claims 3-6, 9-18 and 20-22, the only claims remaining in the application.

We REVERSE.

The appellant's invention pertains to an article for use in catching fish that comprises a non-toxic, lead-free underwater fishing device, at least a portion of which contains a bismuth alloy. Independent claim 21 is further illustrative of the appealed subject matter and a copy thereof may be found in the appendix to the brief.

The reference relied on by the examiner is:

British patent (Jukes)	2207841A	Feb. 15, 1989
------------------------	----------	---------------

The following rejection is before us for consideration:²

Claims 3-6, 9-18 and 20-22 stand rejected under 35 U.S.C. § 103 as being unpatentable over the British patent to Jukes.

GB 2207841A (GB) [Jukes] recognizes the use of non-lead metals in a fishing device to prevent lead poisoning but fails to show the device containing [a] bismuth [alloy]. However, metals such as tin,

² In the answer the examiner made a new ground of rejection based on the combined teachings of Jukes and the Metals Handbook (see page 4 of the answer). Inexplicably, however, the examiner expressly withdrew this rejection in the communication mailed on July 21, 1998 (Paper No. 50).

Appeal No. 95-1971
Application No. 08/126,130

lead, antimony, bismuth, cadmium and indium, and their alloys are well recognized as having a relatively high specific gravity and a low melting point; choosing a metal not containing lead from the group mentioned above, due to their physical properties, can make the fishing device of GB more sinkable (due to their specific gravity) and more easier [sic] for its manufacturing or duplication process (due to their low melting point). Therefore, it would have been obvious to one of ordinary skill in the art to choose bismuth or bismuth alloys to form the non-lead fishing device in GB to prevent lead poisoning. [Answer, page 3.]

In support of this position the examiner observes that Jukes on page 1 states that the materials used in the non-toxic fishing weight may be a) brass, b) stainless steel, c) tungsten, copper, nickel, d) nickel, e) nickel silver, f) steel, g) zinc and h) any other non-lead based material.

We will not support the examiner's rejection. In rejecting claims under 35 U.S.C. § 103 the examiner bears the initial burden of presenting a **prima facie** case of obviousness. **In re Rijckaert**, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); **In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met does the burden of coming forward with evidence or argument shift to the applicant. **Id.** If the examiner

Appeal No. 95-1971
Application No. 08/126,130

fails to establish a **prima facie** case, the rejection is improper and will be overturned. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

As the examiner recognizes there is no disclosure in Jukes of a bismuth alloy. While the examiner makes much of the fact that Jukes states that the fishing weight may be "any other" non-lead based material, we point out that it is well settled that in order to establish a **prima facie** case of obviousness the prior art teachings must be sufficient to suggest to one of ordinary skill in the art to make the modification needed to arrive at the claimed invention. **See, e.g., In re Lulu**, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984). It is of course true that Jukes states on page 1 that "any other" non-lead based material may be used; however, there is no teaching or suggestion in the prior art adduced by the examiner which would have lead one of ordinary skill in this art to single out and select a bismuth alloy from the myriads of possibilities encompassed by this broad disclosure. As to the examiner's contention that it is "well recognized" that bismuth alloys have a high specific gravity and a low

Appeal No. 95-1971
Application No. 08/126,130

melting point, we must point out that the mere fact that, generally speaking, this might be the case does not provide a sufficient factual basis for establishing the obviousness of the appealed subject matter within the meaning of 35 U.S.C. § 103. **See, e.g., In re GPAC Inc**, 57 F.3d 1573, 1582, 35 USPQ2d 1116, 1123 (Fed. Cir. 1995) and **In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968).

The appellant has presented evidence of non-obviousness in the form of a declaration by Fickling and a self-executed declaration. However, since the prior art relied on by the examiner fails to establish a **prima facie** case of obviousness, we need not consider the appellant's evidence of nonobviousness. **In re Fine, supra**, 837 F.2d at 1076, 5 USPQ2d at 1600 (Fed. Cir. 1988).

The decision of the examiner is reversed.

REVERSED

Appeal No. 95-1971
Application No. 08/126,130

JAMES M. MEISTER)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JOHN F. GONZALES)	
Administrative Patent Judge)	

bae

Appeal No. 95-1971
Application No. 08/126,130

George R. Pepper
Rothwell, Figg, Ernst & Kurz
Suite 701-E, 555 13th Street, N.W.
Washington, DC 20004